

Attorney Docket No. 2481.1699-00

In re Application of:

Henning VOLLERT

Group Art Unit: 1743

Application No.: 09/646,986

Examiner: D. Handy

Filed: September 26, 2000

For: MINIATURIZED MICROTITER
PLATE FOR HIGH
THROUGHPUT SCREENING

RECEIVED

DEC 19 2002

TC 1700

Commissioner for Patents
Washington, DC 20231

Sir:

REQUEST FOR RECONSIDERATION

In reply to the Office Action dated June 19, 2002, the period for reply having been extended for three (3) months through December 19, 2002, by a request for extension and fee payment filed concurrently herewith, please consider the following remarks.

In the outstanding Office Action dated June 19, 2002, the Examiner rejected claims 5-14 under 35 U.S.C. § 102(e) as being anticipated by Pham et al., U.S. Patent No. 6,171,780. Applicant notes that only claims 5-13 are pending.

Claim 13 recites a combination including a plastic body, a glass base, the base of the microtiter plate having a thickness ranging from 0.07 to 0.2 mm, a number of vessels for containing samples, wherein the number of vessels ranges from 1000 and 4000 vessels, the diameter of the vessels ranges from 1.0 to 1.8 mm, and the distance

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between the center of the outer vessels and an edge of the glass base ranges from 4 to 11 mm, and a lid to prevent evaporation.

The Examiner asserted that Pham et al. discloses a low fluorescence platform that contains a large number of wells for assaying compounds. The Examiner stated that the platform may contain between 50 and 10,000 wells, that the frame may be made of "any material, such as polymers, such as polystyrene or cycloolefins, or other materials such as glass or quartz." The Examiner further stated that the base may be made of glass, and that the frame and base may be made of the same or different materials.

With regard to the wells, the Examiner stated that the wells may have a diameter of between 0.2 and 50 mm, and a thickness of between 10-1000 micrometers. Finally, the Examiner states that "simply selecting a well-to-well spacing of 0.5 mm for a 96 x 16 1536 well plate in the standard footprint would provide the distance" between the center of the outer vessels and an edge of the glass base of between 4 and 11 mm as "claimed by applicant."

The Examiner rejected claims 5-13 under 35 U.S.C. § 102(e), which states in part that "the invention was described in a patent granted on an application for patent by another." In order to reject a claim under § 102, the reference relied upon by the Examiner must disclose the invention as a whole, and each and every limitation set forth in the claim must be disclosed in that reference. Pham et al. does not disclose the invention recited in independent claim 5. Specifically, Pham et al. does not disclose a distance between the center of the outer vessels and an edge of the glass base of between 4 and 11 mm as recited in independent claim 5. In addition, Pham et al. does

not disclose a lid to prevent evaporation as recited in independent claim 5. Therefore, Pham et al. does not disclose each and every limitation set forth in claim 5, and for at least this reason, Pham et al. cannot anticipate claim 5, or claims 6-13, which depend from claim 5.

In the outstanding Office Action, the Examiner asserted that "simply selecting a well-to-well spacing of 0.5 mm for a 96 x 16 1536 well plate in the standard footprint would provide the distance" between the center of the outer vessels and an edge of the glass base of between 4 and 11 mm. Applicant is unclear whether this comment is intended to be an inherency argument, since the Examiner has not provided a basis in fact or technical reasoning to support this determination. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). If the Examiner is arguing inherency, Applicant reminds the Examiner that the Examiner must provide rationale or evidence tending to show inherency. MPEP § 2112. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

As stated above, Pham et al. does not disclose the invention as claimed. In addition, the Examiner has not provided any rationale or evidence tending to show inherency. For at least these reasons, Pham et al. cannot anticipate claims 5-13.

Reconsideration is requested.

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In view of the foregoing amendments and remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: December 18, 2002

By: 
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